

## REMARKS

### Claim Rejections under 35 U.S.C. § 103.

Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 6,151,586 to Brown (“Brown”) in view of U.S. Pat. No. 5,870,720 to Chusid (“Chusid”).

An invention is unpatentable under 35 U.S.C. § 103(a) (“Section 103”) “if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.”

To establish a *prima facie* case of obviousness, three criteria must be met. “First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2142.

A “clear and particular” showing of the suggestion to combine or modify is required to support an obviousness rejection under Section 103. *Id.* For the reasons set forth below, Applicant submits that the prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicant’s claims are not obvious in view of the prior art references.

As discussed in Applicant’s response to the Office Action of March 14, 2003, Applicant’s independent claims 1, 18 and 20 recite “receiving a request to collect on an unpaid debt.” This claim limitation is neither disclosed nor suggested by any cited reference. Indeed, Brown discloses a computerized reward system for encouraging individual participation in a health management program. Brown neither discloses nor suggests receiving a request to collect on an unpaid debt.

Likewise, Chusid teaches a method for restructuring an excessive underlying mortgage in excess of its current market value, but in no way discloses or suggests receiving a request to collect on an unpaid debt. As “all the claim limitations must be taught or suggested by the prior art,” Applicant respectfully submits that the lack of this claim limitation in any cited reference renders the present invention non-obvious in view of such references.

Moreover, one skilled in the art would not be motivated by either Brown or Chusid to combine the references as the Examiner suggests. Contrary to the Examiner’s assertion that motivation to combine is found in Chusid, col. 4, ln. 51-52, Chusid states only that an object of the invention is to “reduce . . . the purchaser’s share of the underlying mortgage.” (Col. 4, ln. 51-52). Chusid neither discloses nor suggests implementing an incentive program to facilitate reduction of a purchaser’s mortgage. Thus, one skilled in the art would not be motivated by Chusid to look to the incentive program of Brown to incentivize a method of debt reduction.

Further, even if Chusid and Brown were combined as the Examiner suggests, such combination does not result in a method equivalent to the method of the present invention. Rather, all references in Chusid to collection and amortization refer to a service provided to a debtor for reducing his or her debts, essentially a method of debt reduction, and not to a service provided to a service provider or other creditor to collect unpaid debts, essentially a method of debt collection. Thus, even if Chusid were combined with Brown, the resulting combination would likely be directed to an incentive program for encouraging debtors to reduce their debts, not to a program to incentivize a service provider or other creditor to present unpaid accounts to a debt collection agency for collection. Indeed, as Chusid does not presuppose nor suggest any unpaid debt, the Chusid/Brown

combination cannot render obvious a method for encouraging the presentation of unpaid debts to a debt collection agency for collection.

Claims 2-10, 12-17, and 21-23 add further limitations to otherwise allowable subject matter and are thus not rendered obvious by the cited references.

In light of the foregoing, Applicant respectfully submits that the inability of the cited references to produce Applicant's invention and the lack of any suggestion or motivation to combine such art as suggested by the Examiner renders the present invention non-obvious in view of such references. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 1-23 under Section 103.

Claim Rejections under 35 U.S.C. § 101.

Claims 21-23 stand rejected under 35 U.S.C. § 101 ("Section 101") for lack of defining a concrete, useful and tangible result in terms of a specified output.

Section 101 defines patentable subject matter as "any new and useful process, machine, manufacture, or composition of matter, or new and useful improvement thereof."

Claim 20 recites a "computer program product for implementing within a computer system a method for encouraging presentation of unpaid debts for collection," wherein the output comprises "selectively apportioning monies that have been collected on the unpaid debt." A computer program "which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized" is defined as statutory subject matter. MPEP § 2106(II)(C)(a). Claim 20 is thus statutory subject matter. The limitations of claim 20 are incorporated into dependent claims 21-23 by reference. As claims 21-23

place further limitations on otherwise allowable subject matter, such claims also satisfy the statutory requirements of Section 101.

Applicant thus respectfully requests withdrawal of the rejections of claims 21-23 under Section 101.

Conclusion

Based on the foregoing, Applicant believes that the claims of the present invention are in condition for allowance and respectfully requests the same.

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to initiate a telephone interview with undersigned counsel.

DATED this 11 day of November, 2003.

Respectfully submitted,

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